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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Khaishgi; Cara Cherry-
Lisco
Serial No.: 10/672,136 Docket No.: 1018-001US03
Filed: September 26, 2003 Customer No.: 28863
Examiner: Janice A. Mooneyham Group Art Unit: 3629
Title: INTEGRATED ELECTRONIC MARKETPLACE AND ONLINE DISPUTE
RESOLUTION SYSTEM

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being deposited with the United States Post Service, as First Class Mail, in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on September 11, 2006.

By: 

Name: Patricia Cygan

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

We are transmitting herewith the attached correspondence relating to this application:

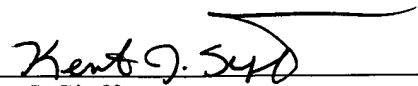
- ☒ Transmittal sheet containing Certificate of Mailing
- ☒ Communication Regarding Supplemental Appeal Brief (3 pgs.)
- ☒ Supplemental Appeal Brief (55 pgs.) in triplicate
- ☒ Fee of \$250.00 for filing appeal brief to be charged to Deposit Account No. 50-1778
- ☒ Return postcard

Please apply any charges not covered, or any credits, to Deposit Account No. 50-1778.

Date: September 11, 2006

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By:


Name: Kent J. Sieffert
Reg. No.: 41,312



PATENT
Docket No.: 1018-001US03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Lalitha Vaidyanathan et al.

Serial No.: 10/672,136

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Mooneyham

For: INTEGRATED ELECTRONIC
MARKETPLACE AND ONLINE DISPUTE
RESOLUTION SYSTEM

COMMUNICATION REGARDING SUPPLEMENTAL APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450,
Alexandria, VA 22313

Dear Sir:

On August 11, 2006, the Examiner issued a Notification of Non-Compliant Appeal Brief, which indicated that the Summary of the Claimed Subject Matter in Appellant's Appeal Brief failed to include a concise explanation of the claimed subject matter. Although Appellant respectfully disagrees with the Examiner's conclusions, Appellant nevertheless hereby submits a supplemental brief including a new summary of the claimed subject matter.

First, before addressing the Examiner's basis for the Notice, Appellant directs the Examiner to MPEP 1205.03, which prevents the Examiner from rejecting an appeal brief for minor non-compliant reasons.

Second, Appellant directs the Examiner to MPEP 1205.02, which specifically states that 37 CFR 41.37(c)(1) specifies the "minimum requirements" for a brief, and "does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable." According to MPEP 1205.02, a brief is in compliant with 37 CFR 41.37(c)(1) as long as it includes items in the order set forth regardless of whether the appellant has included additional

material that he or she considers relevant. It is without question that the Appellant has a right to include information that he feels relevant and material to the appeal, regardless if Examiner disagrees.

In the Notification, the Examiner stated that Appellant's Summary of the Claimed Subject Matter (herein, "Summary") on pages 4-7 is not directed to claimed subject matter. Appellant disagrees. The Examiner stated that "only if the applicant has claimed the limitations do they become relevant." Appellant's reminds the Examiner that the principle issue on appeal is a rejection under 35 USC 112, 1st paragraph, so it is to be expected that Appellant and the Examiner disagree as to what portions of the specification are relevant to the claim language. Appellant submits that Appellant's previous Summary provided a clear nexus between the claim elements and the disclosure with specific reference to the specification and the drawings, and is relevant to the Board's understanding the claims so as to address the 112 rejection. In fact, while describing the relevant portions of FIG. 1 and FIG. 2 on pages 4-7 of the Brief, Appellant provided numerous citations directly linking the elements of independent claim 73 to the Summary. The Examiner should recognize that any references to features of the specification that are relevant and helpful in understanding the claims are certainly permissible and, in fact, desirable, even if the referenced portions of the specification are not identical to the claim language. Further such material is not prohibited by the rules and, as quoted above, MPEP 1205.02 specifically states to the Examiner that the Appellant has a right to include or reference any additional information the Appellant believes is relevant to understanding the claims. In fact, much of the subject matter in the specification referenced in Appellant's previous summary to which the Examiner objected is relevant to the Board in understanding the claim elements currently rejected under 35 USC 112, 1st paragraph. Appellant wishes to note for purposes of review that the Examiner's actions in preventing the Appellant from including information that the Appellant believes is relevant to understanding the claimed subject matter is an abuse of the Examiner's position and prejudicial to Appellant's right to a fair appeal.

In the Notice, the Examiner also stated that Appellant failed to provide an explanation for the subject matter of all dependent claims argued separately as required by 37 CFR 41.37(c)(1)(v). Appellant points out that, contrary to the Examiner's assertion, this rule does not require an explanation of each dependent claim argued separately by the Appellant. Rather, the rule requires identification of corresponding structure, material, or acts in the specification for

each independent claim and dependent claim only in the case of means plus function or step plus function under 35 USC 112, sixth paragraph. Otherwise, only the independent claims involved in the appeal need be explained for compliance with the rule. Appellant's claims do not involve any means-plus-function elements, and the Examiner's position is in error. Appellant has, therefore, not provided a summary of each dependent claim.

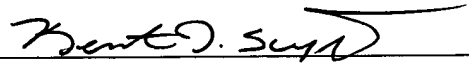
Although Appellant strongly disagrees with the Examiner's basis for issuing the Notice of Non-compliant Appeal Brief, Appellant submits a supplemental brief. Appellant submits that the revised Summary of Claimed Subject Matter provides a clear nexus between the elements of each independent claim and features set forth in the specification. In the attached summary, Appellant has made it clear how features described within the specification and referenced by the attached summary are relevant to the claimed subject matter and help to provide a clear understanding of the claim elements for purposes of this appeal.

Appellant submits that the Supplemental Brief is compliant with the requirements of 37 CFR 41.37(c)(1)(v), and hereby requests prompt advancement of the appeal to the Board.

Date: September 11, 2006

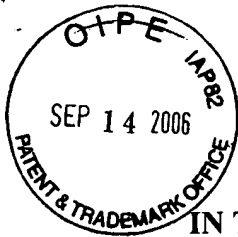
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Reg. No.: 41,312



PATENT
Docket No.: 1018-001US03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Lalitha Vaidyanathan et al.

Serial No.: 10/672,136

Art Unit: 3629

Filed: September 26, 2003

Examiner: Janice A.
Mooneyham

For: INTEGRATED ELECTRONIC
MARKETPLACE AND ONLINE DISPUTE
RESOLUTION SYSTEM

SUPPLEMENTAL APPEAL BRIEF

Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450,
Alexandria, VA 22313

Dear Sir:

This is a Supplemental Appeal Brief from the Notice of Non-compliant Brief mailed August 11, 2006 and the Office Action mailed February 16, 2006. The Notice of Appeal was filed on April 13, 2006. The present application has been rejected more than twice. Appellant submits this Supplemental Appeal Brief in triplicate. Please charge Deposit Account No. 50-1778 in the amount of \$250.00 for the small entity fee for filing a brief in support of an appeal.

Appellant requests the opportunity for a personal appearance before the Board of Patent Appeals and Interferences to argue the issues of this appeal. The fee for the personal appearance will be timely paid upon receipt of the Examiner's Answer. Please also charge any additional fees that may be required or credit any overpayment to Deposit Account No. 50-1778.

09/15/2006 RMEBRAHT 00000079 501778 10672136

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REAL PARTY IN INTEREST

The real party in interest is SquareTrade, Inc. of San Francisco, California.

RELATED APPEALS AND INTERFERENCES

This application is a continuation of and claims priority to Serial No. 09/504,159, filed February 15, 2000, which is also currently under appeal before the Board of Patent Appeals and Interferences.

STATUS OF CLAIMS

Claims 49-73 are on appeal in this case.

Claims 49-73 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Claims 49-61 and 64-73 stand rejected under 35 U.S.C. 102(e) as being anticipated by Collins et al. (U.S. Publication No. 2002/0007362).

Claims 62 and 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Collins.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Rejection mailed February 16, 2006 from which this Appeal has been made.

SUMMARY OF THE CLAIMED SUBJECT MATTER

In this appeal, Appellant separately argues independent claims 49, 58, 66-73. Consequently, independent claims 49, 58, 66-73 are involved in the appeal and summarized below.

Independent claim 73

Appellant first directs the Board to the elements of independent claim 73 as these elements best illustrate the issues presented by this Appeal. Claim 73 reads as follows:

*A system comprising:
an online dispute resolution system that executes a dispute resolution process;
and
an electronic marketplace system that includes:
(i) a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers,
(ii) a database that stores data, and
(iii) a software object that communicates the data from the database to the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system.*

As set forth above, independent claim 73 requires an *online dispute resolution system* and an *electronic marketplace system*. FIG. 1 depicts a dispute resolution system 130 coupled to an electronic marketplace 102 by a network 120.

Claim 73 requires that the online dispute resolution system *execute a dispute resolution process*. Paragraphs 0043-0044, for example, describe use of dispute resolution system 130 of FIG. 1 in resolving disputes. FIG. 6 and related disclosure in paragraphs 0056-0063 describe a process for filing and resolving complaints for online transactions.

Claim 73 requires that the electronic marketplace *include a web server*. The present application states that, in one embodiment, marketplace 102 is an online marketplace that includes a website.¹

Claim 73 requires that the web server of the electronic marketplace *provide a centralized trading place for a plurality of buyers and a plurality of sellers*. Paragraph

¹ Page 11, ll. 5.

0039 states that, in this embodiment, the web server provides an online centralized trading place for buyers 106 and sellers 104.²

Claim 73 requires that electronic marketplace include *a software object that communicates data from a database of the electronic marketplace to the online dispute resolution system*. FIG. 2B and paragraphs 0046-0047 describe a dispute resolution system 150 in which remote software objects (recited as “a software object” in claim 73) allow a system to send specific information to the dispute resolution system.³

Claim 73 also requires that the information communicated from the electronic marketplace to the online dispute resolution system *inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system*. In paragraph 0047, the present application provides a specific example in which the remote software objects may be used to communicate specific information so as to inform the online dispute resolution system of relevant transactions.⁴

Independent claim 49

Independent claim 49 requires *an online dispute resolution system electronically coupled to an electronic marketplace*. As discussed above, FIG. 1 and paragraphs 0039-0040 describe a dispute resolution system 130 coupled to an electronic marketplace 102.

Independent claim 49 requires that *the electronic marketplace stores transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services*. Paragraph 0039 describes sellers 104 and consumers 106 interacting with a website and “consuming transactions” at marketplace 102 with respect to products and/or services.⁵

² Page 11, ll. 5.

³ See [0047] stating describing the use of remote software objects to “provide functionality to receive and send specific information to the dispute resolution system.” See also

⁴ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

⁵ Page 11, ll. 5.

Claim 49 requires that the online dispute resolution system *electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data*. FIG. 2B and paragraphs 0046-0047 describe an embodiment in which dispute resolution system 150 integrates with a partner system and exchanges specific information with the partner system.⁶ Relevant to claim 49, paragraph 0047 provides a specific example in which the specific information informs the online dispute resolution system of relevant “transactions.”⁷

Claim 49 also requires that the dispute resolution system *utilize the received portion of the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions*. FIG. 10 and paragraph 0085 describe an example in which the dispute resolution system executes a predictive reasoning process that utilizes data describing a disputed transaction to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”⁸

Independent claim 58

Independent claim 58 is directed to a method comprising *providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace*. These elements have been summarized with respect to independent claims 73 and 49 above.

⁶ See [0047] stating describing the use of remote software objects to “provide functionality to receive and send specific information to the dispute resolution system.” See also

⁷ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

⁸ In this example, the present application makes clear that dispute resolution system 130 uses facts describing the transaction to search a historical database to identify previous cases with similar facts. Dispute resolution system 130 then retrieves, summarizes and displays the outcomes of the cases similar to the disputed transaction for all parties and the dispute resolution specialist to assist them in resolving the present dispute. Paragraph 0017 describes another example of utilizing the data. Specifically, the dispute resolution system provides a software wizard that first as determines if the dispute is simple in nature and can be resolved without going through the dispute resolution system. If a dispute is found to be simple, the wizard offers a plurality of suggestions for ways of resolving the dispute.

Claim 58 requires *receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute*. As discussed above with respect to claim 49, FIG. 2B and paragraphs 0046-0047 describe an embodiment in which dispute resolution system 150 receives information from a partner system, and provides a specific example in which the information informs the online dispute resolution system of relevant “transactions.”⁹

Claim 58 requires the step of *utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace*. FIG. 10 and paragraph 0085 describe one example of utilizing the data in a computer-implemented predictive reasoning process to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”¹⁰

Independent claim 66

Claim 66 requires *a dispute resolution system electronically coupled to an electronic marketplace for buyers and sellers of goods and services*. FIG. 1 and paragraphs 0039 and 0040 describe a dispute resolution system 130 coupled to an electronic marketplace 102 by a network 120.

Claim 66 requires *a software application to automatically communicate transaction data from a database of the electronic marketplace to a database of the dispute resolution system*. FIG. 2B and paragraphs 0046-0047 describe a dispute resolution system 150 in which remote software objects (recited as “a software object” in claim 66) allow a partner system to send specific information from a partner database 164 to the dispute resolution system.¹¹

⁹ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

¹⁰ In this example, the present application makes clear that dispute resolution system 130 uses facts describing the transaction to search a historical database to identify previous cases with similar facts. Dispute resolution system 130 then retrieves, summarizes and displays the outcomes of the cases similar to the disputed transaction for all parties and the dispute resolution specialist to assist them in resolving the present dispute.

¹¹ See [0047] stating describing the use of remote software objects to “provide functionality to receive and send specific information to the dispute resolution system.” See also

Claim 66 requires that the transaction data be communicated *in response to a transaction within the electronic marketplace by a member of the online dispute resolution system*. Paragraph 0056 of the present application describes that, after a transaction, a buyer or a seller can initiate a dispute. Paragraph 0056 also describes determination of whether the complainant is a member of the online dispute resolution system.

Claim 66 requires that *the transaction data is associated with one or more transactions within the electronic marketplace*. As discussed above, FIG. 2B and paragraphs 0046-0047 provides a specific example in which the specific information is used to inform the online dispute resolution system of relevant “transactions.”¹²

Claim 66 requires that the dispute resolution system *utilize the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions*. FIG. 10 and paragraph 0085 describe one example of utilizing the data in a computer-implemented predictive reasoning process to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”

Independent claim 67

Claim 67 requires *providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace stores transaction data that describes transactions within the marketplace*. These elements have been summarized with respect to claims 73, and 49 above.

Claim 67 requires *automatically communicating the transaction data stored to the online dispute resolution system without human intervention in response to initiation of a dispute*. FIG. 2B and paragraphs 0046-0047 describe an embodiment in which dispute

¹² See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

resolution system 150 receives specific information from a partner system with respect to relevant “transactions” in that system.¹³

Claim 67 requires utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace. FIG. 10 and paragraph 0085 describe one example of utilizing the data in a computer-implemented predictive reasoning process to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”

Independent claim 68

Claim 68 requires *storing transaction data in an electronic marketplace, wherein the transaction data describes transactions within the electronic marketplace*. These elements have been summarized above.

Claim 68 requires *receiving case information with an online dispute resolution system, wherein the case information describes a dispute related to one of the transactions of the electronic marketplace*. Paragraph 0056 describes a buyer or a seller providing identification of the other party and a transaction date with respect to a disputed marketplace transaction.

Claim 68 requires *automatically communicating at least a portion of the transaction data related to the dispute from the electronic marketplace to the online dispute resolution system without manual intervention*. FIG. 2B and paragraphs 0046-0047 describe an embodiment in which dispute resolution system 150 receives specific information from a partner system with respect to relevant “transactions” in that system.¹⁴

Claim 68 requires *executing a dispute resolution process with the online dispute resolution system that utilizes the transaction data from the electronic marketplace and the case information to assist in resolving the dispute*. FIG. 10 and paragraph 0085 describe one example of utilizing the data in a computer-implemented predictive

¹³ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

¹⁴ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

reasoning process to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”

Independent claim 69

Claim 69 requires *storing transaction data in a database of a electronic marketplace, wherein the transaction data describe transactions within the electronic marketplace*. These elements have been summarized above with respect to claim 73.

Claim 69 requires *receiving case information with an online dispute resolution system from one or more parties, wherein the case information describes a dispute related to one of the transactions of the electronic marketplace*. These elements have been summarized above with respect to claim 68.

Claim 69 requires *executing a dispute resolution process with the online dispute resolution system that receives at least a portion of the transaction data stored from the database of the electronic marketplace without human intervention in response to initiation of the dispute and uses the received portion of the transaction data and the case information from the parties to assist the parties in resolving the dispute*. These elements have been summarized above with respect to claim 58.

Independent claim 70

Claim 70 requires *an online dispute resolution system that presents an interface for receiving case information from one or more parties*. Paragraph 0056 describes an embodiment in which a buyer or a seller interacts with a software wizard and provides case information (e.g., identification of the other party and a transaction date) with respect to a disputed marketplace transaction.

Claim 70 requires *an electronic marketplace system that includes: a database that stores transaction data that describe transactions*. FIG. 2B shows a partner database 164 of a partner system, and paragraph 0047 describes information describing transactions conducted within that partner system.

Claim 70 requires *and a software object that automatically communicates the transaction data from the database to the online dispute resolution system when transactions within the electronic marketplace are performed by members of the online*

dispute resolution system. FIG. 2B and paragraphs 0046-0047 describe an embodiment in which a remote software object sends specific information from a partner database 164 of a partner system, where the specific information can describe relevant “transactions” in that system.¹⁵

Claim 70 requires that *the online dispute resolution system executes a dispute resolution process that utilizes the transaction data and the dispute information to assist the parties in resolving the dispute*. These elements have been summarized above with respect to claim 49.

Independent claim 71

Claim 71 requires *an online dispute resolution system having a database of case information for a dispute*. FIG. 2B shows a database server 160 of a dispute resolution system 150.

Claim 71 requires that an electronic marketplace system that includes: a database that stores transaction data that describe transactions for buyers and sellers. Paragraph 0039 refers to FIG. 1 and describes marketplace 102 as having a web server that provides an online centralized trading place for buyers 106 and sellers 104. FIG. 2B shows a partner database 164 of a partner system, and paragraph 0047 describes information describing transactions conducted with that partner system.

Claim 71 requires *a software object executing within the electronic marketplace system that automatically communicates the transaction data from the database to the online dispute resolution system without human intervention in response to initiation of a dispute*. FIG. 2B and paragraphs 0046-0047 describe remote software objects that receive and send specific information to the dispute resolution system with respect to relevant transactions.¹⁶

¹⁵ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

¹⁶ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

Claim 71 requires *a software object executing within the electronic marketplace system that queries the database of the online dispute resolution system for status for at least one user of the electronic marketplace system*. The present application provides an additional example in which the communication functions of FIG. 2B may be used by a partner system to *query* the online dispute resolution system to determine a specific *status* of a marketplace seller 104.¹⁷

Independent claim 72

Claim 72 requires *a server that provides an electronic marketplace system, and a plurality of client computers by which buyers and sellers interact with the electronic marketplace system*. The present application states that, in one embodiment, marketplace 102 is an online marketplace that includes a website.¹⁸ Paragraph 0039 specifically states that, in this embodiment, the web server provides an online centralized trading place for buyers 106 and sellers 104.¹⁹

Claim 72 requires *an online dispute resolution system having at least one server that communicates with a database of the electronic marketplace system without human intervention in response to initiation of a dispute*. FIG. 2B and paragraphs 0046-0047 describe a dispute resolution system 150 in which remote software objects (recited as “a software object” in claim 73) allow a system to receive and send specific information to the dispute resolution system.²⁰

¹⁷ See 0047 stating that “[e]xample functionality includes ... allowing partners to query the dispute resolution system data such as the *status* of a specific marketplace seller 104 (emphasis added).”

¹⁸ Page 11, ll. 5.

¹⁹ Page 11, ll. 5.

²⁰ See [0047] stating describing the use of remote software objects to “provide functionality to receive and send specific information to the dispute resolution system.” See also

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellant submits the following three grounds of rejection to be reviewed on Appeal:

1. The first ground of rejection to be reviewed on appeal is the rejection of claims 49-73 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.
2. The second ground of rejection to be reviewed on appeal is the rejection of claims 49-61 and 64-73 under 35 U.S.C. 102(e) as being anticipated by Collins et al. (U.S. Publication No. 2002/0007362).
3. The third ground of rejection to be reviewed on appeal is the rejection of claims 62 and 63 under 35 U.S.C. § 103(a) as being unpatentable over Collins.

Appellant submits that the second and third grounds of rejection are rendered moot if the Board reverses the rejection under 35 U.S.C. 112, first paragraph. The Examiner based the second and third grounds for rejection on subject matter first available after Appellant's original priority date, which the Examiner refused to recognize in view of the rejection under 35 U.S.C. 112, first paragraph.

ARGUMENTS

The First Ground of Rejection

Appellant's claims 49-73 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. With respect to the first ground of rejection, Appellant argues claims 49-73 separately, as set forth below.

Standard for compliance with the written description requirement

The first issue for review by the Board is the Examiner's failure to apply the proper standard when rejecting Appellant's claims 49-73 under 35 U.S.C. 112, first paragraph. For a claim to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can *reasonably conclude* that the inventor had possession of the claimed invention.²¹ It is well established that satisfaction of the written description requirement does not require the presence or absence of literal support.²² Claim limitations can be satisfied through express, implicit or even inherent disclosure.²³

The Examiner has committed legal error by improperly disregarding this rule of law. Instead of properly evaluating the disclosure for evidence that the inventor had possession of the claimed invention, the Examiner has required express disclosure, i.e., verbatim language within the specification, for the claim limitations.

In the Office Action mailed July 25, 2005, the Examiner rejected Appellant's claims under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In a Response mailed November 23, 2005, Appellant respectfully traversed the rejection and identified substantial disclosure within the specification to demonstrate that the specification describes the claimed invention in

²¹ See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116; See also, *In re Kaslo*, 707 F. 2d 1366, 217 USTP 1089 (Fed. Cir. 1983).

²² *Id.*

²³ See MPEP 2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, "Written Description" Requirement, pg. 5.

sufficient detail to permit one skilled in the art to *reasonably conclude* that the inventor had possession of the claimed invention at the time the application was filed.

In the Final Office Action mailed April 4, 2006, the Examiner maintained the rejection. Although the Examiner included boilerplate language that described the correct standard for adequate written description,²⁴ the Examiner ignored binding precedent and applied a completely different standard that finds no basis in the law. In particular, the Examiner required express disclosure of every feature set forth in the claims. The Examiner's analysis in support of the rejection under 35 U.S.C. 112, first paragraph are set forth in pages 2-10 of the Final Office Action. Unfortunately, the analysis amounted to a mere pasting of Appellant's claims (pp. 3-7), a list of questions, and a statement that the Examiner failed to identify the claim limitations by way of a text search of the original disclosure (pp. 9, ln. 8). From the limited scope of this analysis, it is clear that it did not conform to the law.

On pages 23 and 24 of the Final Office Action, the Examiner's first addressed Appellant's remarks in the Response dated mailed November 23, 2005 by first stating that she disagreed with the standard necessary to show compliance with the written description requirement. In particular, the Examiner stated:

The Examiner does not agree with the applicant's assertion that a written description must describe the claimed invention in sufficient detail so that one skilled in the art can *reasonably conclude* that the inventor had possession of the claimed invention. (emphasis original).²⁵

Importantly, the Examiner herself highlighted the terms "reasonably conclude" to emphasize that she expressly disagreed with this as the applicable standard and, therefore, was not applying it as the standard. The Examiner's unwillingness to apply the proper legal standard, whether she agrees with it or not, constitutes clear legal error. For this reason alone, the rejection must be reversed.

Further statements made by the Examiner indicate that her analysis is grounded on the premise that the claim limitations must be "expressly disclosed" by the present

²⁴ Final Office Action mailed April 4, 2006, page 2 (using language of "reasonably convey").

²⁵ Id at pp. 24-25.

application in order to meet the written description requirement.²⁶ For example, the Examiner rejected the notion that implicit or inherent disclosure of Appellant's specification can be used to satisfy the written description requirement. The Examiner characterized Appellant's argument as asking the Examiner to rely on implicit or inherent disclosure within the present application to satisfy the written description requirement, but explicitly refused to apply this standard because Appellant "does not give the same implicit or inherent consideration to the prior art" relied upon by the Examiner.²⁷ The Examiner did not seem to appreciate the difference between an issue of written description under 35 U.S.C. 112, first paragraph, and an issue of anticipation under 35 U.S.C. 102. Instead, the Examiner refused to apply the proper standard to show compliance with the written description requirement.

First, MPEP 2163.02 specifically addresses the standard for determining compliance with the written description requirement. In this section, consistent with legal principles, the MPEP states that whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with *reasonable clarity* to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.²⁸ MPEP 2163, heading 1, states that a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can *reasonably conclude* that the inventor had possession of the claimed invention. The Examiner's disregard for this standard, relying instead on a legally unsupported and requirement of express disclosure, is reversible legal error.

Second, the Examiner also committed legal error by refusing to consider implicit or inherent disclosures of the present application to satisfy the written description requirement. This is, in fact, the legal standard. MPEP 2163.03 expressly states that the subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement.

²⁶ Id at pg. 24, ll. 7-12 (where the Examiner states "[s]ince the claim limitations are not expressly disclosed, applicant is asking the Examiner to rely on implicit or inherent disclosure to satisfy the written description requirement ... [but this will not be considered because], applicant does not give the same implicit or inherent consideration to the prior art.")(emphasis added).

²⁷ Id at pg. 24, ll. 7-12.

²⁸ MPEP 2163.02 (emphasis added).

Third, the Examiner's apparent justification for her refusal to consider implicit or inherent of Appellant's disclosure due to the prior art is erroneous.²⁹ In this case, the Examiner has cited prior art filed after Appellant's priority date of February 15, 2000, but which claims priority to three U.S. provisional applications filed prior to the priority date of the present application. Instead of applying the proper standard to determine Appellant's compliance with the written description, the Examiner has disregarded this standard, relying instead on a legally unsupported requirement of express disclosure, in order to reject Appellant's claims in view of prior art first available after Appellant's priority date. However, the breadth of disclosure in the prior art is a completely separate issue and should not impact the analysis of the claimed invention for support. The Examiner cannot require express disclosure by the inventor so as to cite improper prior art. The Examiner is required to apply the correct standard for determining whether the inventors had possession of the claimed invention at the time of filing regardless of the breadth of disclosure of the prior art.³⁰

For at least these reasons, the Examiner committed legal error in issuing the rejection under 35 U.S.C. 112, first paragraph, by requiring Appellant's application to expressly disclose the claim elements by using the exact same words. The Examiner's reasoning is founded on the argument that Appellant's claim limitations "are not expressly disclosed," and she expressly declined to consider inherent or implicit disclosures of the present application. The Board should reverse the rejection under 112, first paragraph for this legal error.

Compliance with the written description requirement

Appellant now separately addresses claims 49-73 with respect to compliance with the written description requirement. Upon thorough review of Appellant's specification, a person of ordinary skill in the art would reasonably conclude that Appellant was in

²⁹ Final Office Action at pg. 24, ll. 7-12.

³⁰ With respect to the prior art and whether the prior art is entitled to its earliest priority date as established by its provisional documents, the Examiner is required to separately apply the proper standard to determine whether the prior art's provisional documents comply with the requirements of 35 U.S.C. 112 with respect to the cited subject matter. MPEP 2136.03 The Examiner has made no showing whatsoever with respect to the prior art, and refusing to apply the proper stand to Appellant's disclosure is legal error.

possession of the claimed invention at the time of filing. Appellant request the Board should reverse the rejection under 112, first paragraph.

Independent claim 73

To demonstrate compliance with the written description requirement, Appellant first directs the Board to the elements of independent claim 73 as these elements best illustrate the issues presented by the Appeal. Independent claim 73 is currently rejected as failing to comply with the written description requirement. Claims 73 reads as follows:

*A system comprising:
an online dispute resolution system that executes a dispute resolution process;
and
an electronic marketplace system that includes:
(i) a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers,
(ii) a database that stores data, and
(iii) a software object that communicates the data from the database to the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system.*

Examiner's basis for rejection under 35 USC 112, 1st paragraph

With respect to claim 73, the Examiner did not dispute that the present application describes an online dispute resolution system that executes a dispute resolution process or an electronic marketplace system that includes a web server that provides a centralized trading place for a plurality of buyers or sellers.

As a basis for the rejection 112, first paragraph, the Examiner first asserted that the specification fails to provide support for the claim elements that the electronic marketplace includes a database that stores data describes transactions performed by the plurality of buyers and sellers with the electronic marketplace system.³¹

³¹ Final Office Action at pg. 69 rejecting claim 3 by referring to the rejection generally; See pg. 3, item 4 (where the Examiner highlights the claim language "wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace"); See pg. 9 (where the Examiner specifically asks "where is there support for the **database of the electronic marketplace or wherein the electronic marketplace includes a database that stores transaction data that describes transactions with the marketplace**) (emphasis original); See also pg. 29, 4th paragraph (where the

Second, the Examiner asserted that the present application does not describe an online marketplace system communicating with the online dispute resolution system.³² As one example, in forming the basis for the rejection, the Examiner stated “[w]here in the disclosure is there support for an electronic marketplace system [having] a web server that provides a centralized trading place for a plurality of buyers and sellers with a database that stores data and a software object that communicates the data from the database to the online dispute resolution system?”³³

As set forth above, independent claim 73 requires an *online dispute resolution system* and an *electronic marketplace system*. Claim 73 requires that the electronic marketplace *include a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers*.

FIG. 1 of the present application, reproduced below, illustrates one or more sellers 104 (recited as “a plurality of sellers” in claim 73) that offer their products and/or services to one or more consumers 106 (recited as “a plurality of buyers” in claim 73) at a marketplace 102 (recited as “an electronic marketplace system” in claim 73).

Examiner takes the position that the specification does not clearly establish that the online marketplace has a database that stores partner transactions).

³² Id at pg. 29.

³³ Id at pg. 9, ll. 4-8.

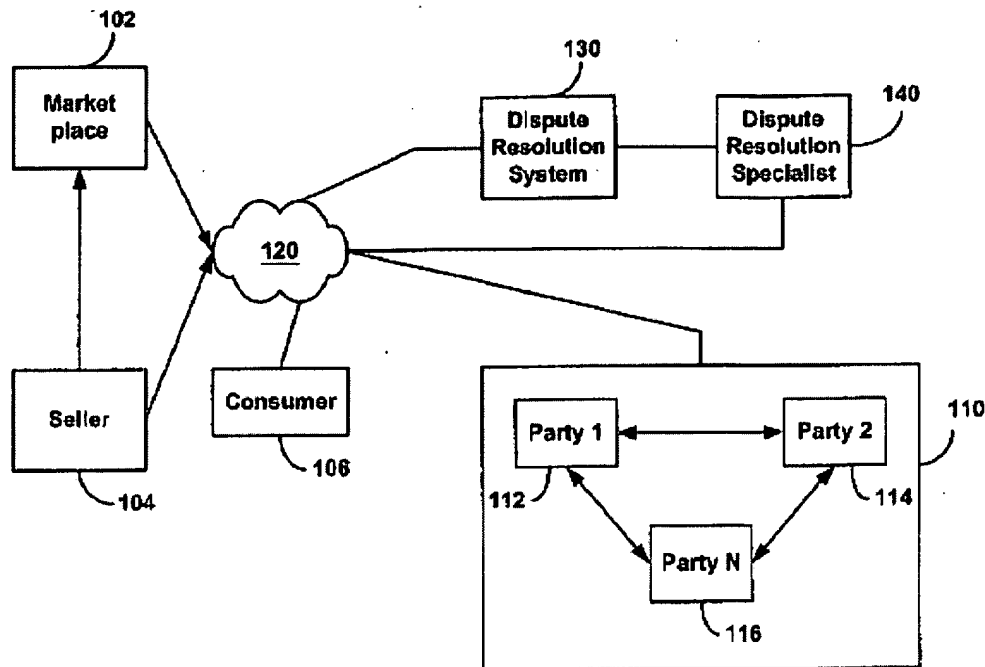


FIG. 1

The present application describes an online marketplace 102 as “a website or an online centralized trading place.”³⁴ This provides direct, literal support for the language of claim 73, reciting an “electronic marketplace system that includes a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers.” The present application gives a specific example of an online marketplace as www.eBay.com, which is a well-known centralized electronic trading place.³⁵ FIG. 1 also depicts a dispute resolution system 130 (recited as a “dispute resolution system” in claim 73) coupled to marketplace 102 by network 120.

Claim 73 requires that electronic marketplace include *a software object that communicates a data from the database to the online dispute resolution system*. Claim 73 further requires that the information communicated from the electronic marketplace to the online dispute resolution system *inform the online dispute resolution system of*

³⁴ Present application at 0039.

³⁵ Present application at 0040.

transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system.

With respect to these elements, FIG. 2B shows a “second implementation” 150 of the invention in which the dispute resolution system integrates with a business partner’s system, such as the online marketplace 102 of FIG. 1. For the convenience of the Board, paragraphs [0046]-[0048] describing FIG. 2B are reproduced in their entirety below:

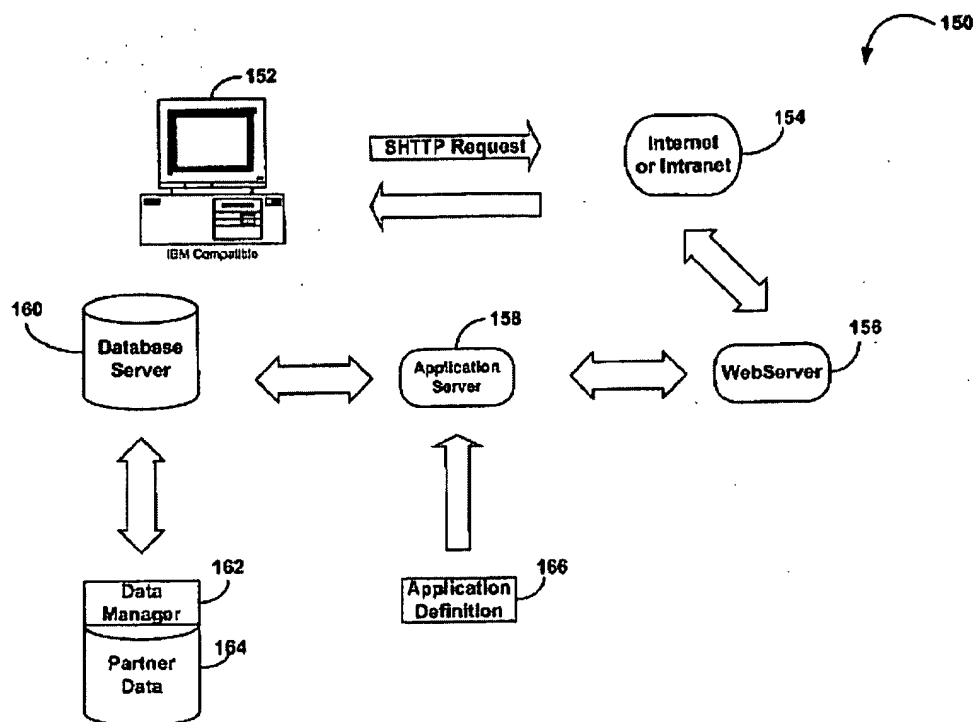


FIG. 2B

[0046] Referring now to Fig. 2B, a second implementation 150 of the dispute resolution system is shown. In this implementation, a customer (which can be either the seller or the buyer) or a dispute resolution specialist can access data using a web browser on a workstation 152. The data is securely transferred between the workstation 152 to a network 154. The network 154 can be the Internet or can be an intranet. A server 156 communicates with the network 154. The server 156 also communicates with a second server 158, which can be an e-commerce server such as the ColdFusion server, available from Allaire Inc. The server 158 is used as a Web Application Server to present HTML applications. These applications allow customers to file and manage disputes and dispute resolution specialists to manage cases over the Internet.

[0047] The server 158 receives data from a set of remote objects that reside in the partner’s system 166. The remote objects, which can be enterprise Java Beans, are provided to allow business partners of the system to integrate with the dispute

resolution system. Both DCOM objects and Enterprise Java Beans models can be used. These objects provide functionality to receive and send specific information to the dispute resolution system 130. The objects will transparently deal with communication issues including server unavailability and performance. Example functionality includes informing the dispute resolution system 130 of relevant partner transactions and allowing partners to query the dispute resolution system data such as the status of a specific marketplace seller 104.

[0048] The server 158 in turn communicates with a structured query language (SQL) server 160. The SQL server 160 also communicates with a data manager 162. The data manager 162 in turn communicates with one or more partner databases 164. Partners integrate with the system, by exposing relevant functionality on their respective websites, for example, allowing customers to dispute a transaction. This integration is achieved by a predefined set of URLs that a partner embeds in the partner's HTML application.

Paragraph [0046] and FIG. 2B describe how a buyer or a seller can use a web browser and workstation 152 to file and manage disputes. Paragraph [0047] then describes functionality by which server 158 of dispute resolution system 150 is capable of receiving data from a set of remote objects that reside within a partner's system 166. In paragraph [0047], the present application expressly states that server 158 is capable of receiving data from a set of remote objects (recited in claim 73 as the electronic marketplace having "a software object") that reside in the partner's system 166. Paragraph [0047] states that example functionality includes the remote software objects as "informing the dispute resolution system 130 of relevant partner transactions." Paragraph [0047] provides the specific example of the remote software objects sending and receiving information to the online dispute resolution system to inform the dispute resolution system of relevant partner transaction (recited in claim 73 as "inform[ing] the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system").³⁶ Paragraph [0047] literally uses the term "partner transactions" when illustrating an example of communication with respect to FIG. 2 between a partner system and the online dispute resolution system. FIG. 2, shown above, shows a data manager 162 and a bidirectional arrow between database server 160 of the online dispute resolution system 150 and the partner database 164.

³⁶ See 0047 stating that "[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*" (emphasis added).

Paragraph [0048] describes a data manager 162 within the online dispute resolution system 150 in communication with one or more partner databases 164. Paragraph [0048] concludes by stating that the software objects and data manager 162 thus allow partner systems to “integrate” with the online dispute resolution system, including exposing relevant functionality of the online dispute resolution system from “their respective websites.”

In view of the Examiner’s statements, it appears that the entire basis for the rejection under rejection 112, first paragraph, is the Examiner’s misinterpretation of FIG. 2B and the disclosure presented above. In particular, the Examiner appears to have concluded that the described “partner system” is limited to individual buyers or sellers. Based on this incorrect interpretation, the Examiner concluded that the present application fails to provide support for the claim elements set forth above. This position is incorrect, and the rejection 112, first paragraph should be reversed for at least the following reasons.

First, the present application states that the embodiment described in paragraphs 0046-0048 and FIG. 2B allow a “partner system” to “integrate” the functionality of the online dispute resolution system with their “respective website.”³⁷ Other than online dispute resolution system 150, the *only* other electronic system described by the inventors in the present application as having a website is electronic marketplace 102 of FIG. 1 that provides a website for hosting a centralized trading place for buyers and sellers.³⁸

Further, paragraph [0048] states that, by way of integration with the partner website, “customers” of that partner system may dispute a transaction. The term “customers” is defined in paragraph [0046] to include “buyers and sellers.” Thus, the literal language of the present application makes clear that the inventors contemplated that the partner system includes a website with which the online dispute resolution system can be integrated, and that the partner system support customers that are both buyers and sellers. This provides strong, undeniable evidence that the inventors contemplated the

³⁷ Present application, paragraph [0048].

³⁸ Id at [0039].

electronic marketplace of FIG. 1 and its website as an example of the partner system described in FIG. 2B.

As further evidence, with respect to FIG. 2B, paragraphs [0047-0048] expressly refer to the partner system as having a partner database 164 that stores partner data 164. Paragraphs [0047, 0048] provide an example in which data communicated from the partner system by way of data manager 162 relate to “partner transactions” for customers, which are described in [0046] as both buyers and sellers. The *only* electronic system described in the present application prior to FIG. 2B that would store transaction data for both buyers and sellers is the electronic marketplace 102 of FIG. 1. This provides further evidence that the inventors considered the electronic marketplace of FIG. 1 as an example partner system described in FIG. 2B.

Further, literally, the last sentence of paragraph 47 (which is referring to FIG. 2B) states “example functionality includes...allowing partners to query the dispute resolution system data such as the status of a specific marketplace seller 104.” This is supportive of Appellant’s position in multiple ways. First the sentence refers back to a “seller 104” shown in FIG. 1 as a customer of the marketplace system 102. Secondly, the term “marketplace” is explicitly used in the sentence **interchangeably** with “partner,” i.e., that the partner system queries a “**marketplace** seller” and not simply a “**partner** seller.” This evidence strongly indicates that inventors contemplated that, in at least in certain embodiments, the electronic marketplace 102 and its website described in FIG. 1 is an example of a partner system that may be integrated with the online dispute resolution system as shown in FIG. 2B.

The evidence set forth above, and in further view of the totality of the description within the present application, makes very clear, either explicitly or by implication, that the inventors viewed electronic marketplace 102 of FIG. 1 as at least an example of a partner system with which the online dispute resolution could be integrated, as described with respect to FIG. 2B. Moreover, this evidence makes clear that the partner system and the online dispute resolution systematically interact to share data related to transactions within the marketplace. Further, when the disclosure is properly viewed, it is clear that the partner system is not an individual buyer or seller, as apparently assumed by the Examiner. Such an assumption would be contextually inconsistent with much of the

evidence set forth above which makes clear the present application describes the partner system as providing a website and database that can integrated with the online dispute resolution system such that customers (both individual buyers and sellers) can interact with that partner system to dispute transactions.

In view of at least the evidence identified above, one of ordinary skill in the art of electronic marketplaces would have reasonably concluded that the inventors contemplated electronic marketplace 102 of FIG. 1 as an example partner system. Therefore, it becomes abundantly clear that the present application offers sufficient support for the claim elements questions by the Examiner.

With respect to the Examiner's assertion that the specification fails to provide support for an electronic marketplace including a database that stores data describing transactions performed by the plurality of buyers and sellers within the electronic marketplace system, paragraph [0048] and FIG. 2 expressly describe a partner system as having "partner databases 164" (recited in claim 73 as "a database that stores data"). The term "partner database" is literally used within the present application. FIG. 2B even shows a database storing partner data 164. Paragraphs [0047, 0048] describes the data as related to "partner transactions" for "customers," which is defined to include "buyers and sellers" in paragraph [0046]. Having established that one of ordinary skill would reasonably conclude that the inventors contemplated at least one embodiment in which the online marketplace 102 was a "partner system," the disclosure clearly supports describing the partner system as having a database that stores data describing transactions performed by the plurality of buyers and sellers, as required by independent claim 73.

With respect to the Examiner's assertion that she was unable to find support for an online marketplace system that communicates with the online dispute resolution system, paragraph [0047] states that server 158 (FIG. 2 above) receives data from a set of objects" (recited in claim 73 as the electronic marketplace having "a software object") that "reside in the partner's system 166." Moreover, paragraph [0048] describes a data manager 162 software object within the online dispute resolution system 150 in communication with one or more partner databases 164. Thus, one of ordinary skill would reasonably conclude that the inventors were in possession of at least one embodiment in which a partner system includes a software object that communicates the

data with the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system, as required by claim 73.

With respect to the Examiner's assertion that she was unable to find support for the claim element that the online dispute resolution system electronically receives data that informs the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace *system*, paragraph [0047] further states that example functionality includes the remote software objects as "informing the dispute resolution system 130 of relevant partner transactions."

Paragraph [0047] literally uses the term "partner transactions" when illustrating an example of communication with respect to FIG. 2 between a partner system and the online dispute resolution system. FIG. 2, shown above, literally shows a data manager 162 and a bidirectional arrow between database server 160 of the online dispute resolution system 150 and the partner database 164. Paragraph [0047] provides a specific example of the remote software objects sending and receiving information to the online dispute resolution system **to inform the dispute resolution system of relevant partner transactions** (recited in claim 73 as "inform[ing] the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system").³⁹ FIG. 2 illustrates an example of data communication between the database 160 of the dispute resolution system and partner database 164, and paragraph [0047] specifically provides an example of such communication as informing the dispute resolution system 150 of transactions within the partner system. Thus, one of ordinary skill would reasonably conclude that the inventors were in possession of at least one embodiment in which an electronic marketplace system includes a software object that communicates the data from the database to the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system, as required by claim 73.

³⁹ See 0047 stating that "[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*" (emphasis added).

For at least these reasons, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention as recited by independent claim 73. The Board should reverse the rejection of independent claim 73 under 112, first paragraph. Appellant now addresses specific requirements of the other claims 49–72 also rejected by the Examiner.

Independent claims 49 and 58

With respect only to independent claims 49 and 68, the Examiner asserted that she was unable to find support that the online marketplace system communicate transaction data to the online dispute resolution system electronically *without requiring manual entry of the transaction data*.⁴⁰

As shown above, one of ordinary skill would reasonably conclude that the inventors were in possession of at least one embodiment in which data is communicated between the systems, e.g., from a partner database 164 of a marketplace, as a partner system, to the database 160 of online dispute resolution system 150 to inform the dispute resolution system of transactions by the buyers and sellers.

Direct integration or communication between the systems, e.g., by way of database to database communication, as described by the inventors, would, inherently, avoid manual reentry of the communicated data into the online dispute resolution system. Moreover, according to the present application, the remote software objects of the partner system will “transparently deal with communication issues” including server unavailability and performance when communicating data to the database of online dispute resolution system 130.⁴¹ These sections make clear that the software objects *transparently* communicate the partner data from the partner system to the online dispute resolution system 130. Thus, although the specification does not include the exact words of “communicat[ing] transaction data to the online dispute resolution system electronically without manually entering the transaction data into the dispute resolution

⁴⁰ Id at pg. 8, paragraph 4.

⁴¹ Para. [0047].

system,” it is clear that the present inventors contemplated and described certain embodiments of transparent electronic transfer of transactions from the database 164 of the marketplace 102 to the database 160 of the online dispute resolution system. If indeed manual reentry of transactions were required by online dispute resolution system, contrary to the second embodiment 150 of the present application, then partner database 164 would not be accessed and server 156 would not “receive data” from the database informing the online dispute resolution system 130 of “partner transactions,” as expressly described by the present application.

Independent claims 49 and 58

With respect to claims 49 and 58, the Examiner first asserted that she was unable to find support for the limitation of “wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace.” The Examiner then asserted that she was unable to find support for the limitation of “electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute.” Finally, the Examiner asserted that she was unable to find support for “utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.”

As set forth above, a person skilled in the art at the time the application was filed would reasonably conclude that the inventor was in possession of the claimed limitation that the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace. Moreover, as also addressed above, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claimed limitation of electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute.

The present application provides numerous examples of dispute resolution system 130 as utilizing data describing the transaction to assist buyers and sellers in resolving the disputes related to those transactions. As one example, FIG. 10 shows “a predictive

reasoning process 500” in which the dispute resolution system 130 utilizes data describing a disputed transaction to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”⁴² In this example, the specification makes clear that dispute resolution system 130 uses data describing the transaction to search a historical database to identify previous cases with similar facts. Dispute resolution system 130 then retrieves, summarizes and displays the outcomes of the cases similar to the disputed transaction for all parties and the dispute resolution specialist to assist them in resolving the present dispute.

For at least these reasons, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention as recited by independent claim 49 and 58. The Board should reverse the rejection under 112, first paragraph.

Dependent claim 52

With respect to claim 52, the Examiner asserted that she was unable to find support for the limitation of “wherein the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace.”

As discussed above, paragraph [0048] expressly refers to a partner system as having “partner databases 164” and as sending information related to transactions within that system. At paragraph [0048], the present application describes another example in which the online dispute resolution system 150 as having a structured query language (SQL) server 160 of the dispute resolution system 150 that communicates with a data manager 162, which “in turn *communicates with one or more partner databases 164.*” Relevant to claim 52, paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to query the dispute resolution system data such as the status of a specific marketplace seller 104. This makes clear that the software objects executing on the marketplace system or any other partner system may electronically query (via SQL or other format) online

⁴² Para. [0085].

dispute resolution system 130, receiving status of specific marketplace sellers 104 in response to that query and updating partner databases 164.

Thus, a person skilled in the art at the time the application was filed would have reasonably concluded that the inventor was in possession of the claim limitation that the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace, as required by claim 52. The Board should reverse the rejection under 112, first paragraph.

Dependent claim 53

With respect to claim 53, the Examiner asserted that she was unable to find support for the limitation of “a server to service electronic requests issued by a server within the electronic marketplace and to exchange data between the online dispute resolution system and the electronic marketplace.”

As discussed above, paragraph [0048] of the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 of the dispute resolution system 150 that communicates with a data manager 162, which “in turn communicates with one or more partner databases 164.” Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to inform the online dispute resolution system of transactions at the marketplace (thus communicating data from the marketplace 102 to the online dispute resolution system 130) as well as functionality to query the dispute resolution system 130 data and receive data in return. This makes clear that in the described second implementation data can be communicated in *both* directions between marketplace 102 and online dispute resolution system 130, e.g., data from the partner system to the online dispute resolution system 130 to inform the dispute resolution system of transactions, and status data from the online dispute resolution system 130 back to the partner system.

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system includes a server (e.g., SQL server 160) to service electronic requests (e.g., queries) issued by a server within the electronic marketplace and to

exchange data (e.g., partner data and status information) between the online dispute resolution system and the electronic marketplace, as required by claim 53. The Board should reverse the rejection under 112, first paragraph.

Dependent claim 54

With respect to claim 54, the Examiner asserted that she was unable to find support for the limitation of “a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace.”

As discussed above, paragraph [0048] expressly refers to the partners systems as having “partner databases 164.” Further, paragraph [0048] of the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 (shown as a “database server 160” in FIG. 2B) of the dispute resolution system 150 communicates with a data manager 162, which “in turn communicates with one or more partner databases 164.”

Moreover, the present application makes clear that these software objects executing at the partner system (e.g., the marketplace) interact with data manager 162 to provide functionality to automatically send and receive specific information to and from the dispute resolution system 130. According to the present application, the objects will “transparently deal with communication issues.”⁴³ This makes clear that the software objects transparently handle communication of the partner data from the partner system to the online dispute resolution system 130.

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system include a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace, as required by claim 54. The Board should reverse the rejection under 112, first paragraph.

⁴³ Para. [0047].

Dependent claim 55

With respect to claim 55, the Examiner asserted that she was unable to find support for the limitation of “wherein the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a database of the electronic marketplace.”

As discussed above, paragraph [0048] expressly refers to the partners systems as having “partner databases 164.” At paragraph [0048], the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 of the dispute resolution system 150 that communicates with a data manager 162, which “in turn communicates with one or more partner databases 164.” Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to query the dispute resolution system data such as the status of a specific marketplace seller 104. This makes clear that the software objects executing on the marketplace system or any other partner system may electronically query (via SQL or other format) online dispute resolution system 130 and in return receive status of specific marketplace sellers 104. The present application describes one example of data maintained by the online dispute resolution system as data that relates to the “participation in the dispute resolution process, or can relate to compliance of a participant to the final decision made in the resolution of the dispute.”⁴⁴

It would be apparent to a person skilled in the art that, in view of the totality of Appellant’s teachings, that the data related to the participation of the seller or compliance with a final decision is one type of data that could be automatically communicated to the marketplace via data manager 162, possibly in response to the described queries via the remote software objects executing with the partner’s system. Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a

⁴⁴ Para. [0011].

database of the electronic marketplace, as required by claim 55. The Board should reverse the rejection under 112, first paragraph.

Dependent claims 51 and 60

With respect to claims 51 and 60, the Examiner asserted that she was unable to find support for the limitation of an online dispute resolution system that “electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system.”

As one example of support for this limitation, Fig. 4 is a diagram illustrating a process 240 executed by the dispute resolution system whereby a seller can request coverage from the dispute resolution system. Block 240 of FIG. 4 clearly shows the request being initiated at the partner system (see block 240 of FIG. 4), which has been established above as representing electronic marketplace 102 in at least one embodiment. Upon receipt of a request to initiate coverage from the partner system, the online dispute system 130 of Fig. 1 provides the seller with a welcome page 242 wherein the seller can complete the registration process. Blocks 248 and 250 show links for returning the seller to the *partner site* (see, e.g., hyperlinks of “Back to Partner” and “List of Partner Sites”).

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system, as required by claim 60. The Board should reverse the rejection of claims 51 and 60 under 112, first paragraph.

Dependent claims 61 and 62

With respect to claim 61, the Examiner asserted that she was unable to find support for the limitations of “electronically communicating data that relates to the online dispute resolution process to the database of the electronic marketplace, and updating the electronic marketplace based on the data received from the dispute resolution system.”

With respect to claim 62, the Examiner asserted that she could not find support for

controlling the appearance of the visual indicia as a function of data received from the dispute resolution system for the users in response to resolution of the disputes.

For reasons set forth above, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation of electronically communicating data that relates to the online dispute resolution process to the database of the electronic marketplace. Support for this element has been demonstrated above.

With respect to the limitation of updating the electronic marketplace based on the data received from the dispute resolution system, the present application describes a registration process in which the online dispute resolution system 130 updates a membership profile database, notifies the applicant of acceptance, and sends electronic data (indicia) to be displayed on the seller's point of sale to indicate membership in the dispute resolution process.⁴⁵ Thus, the present application makes clear that the online dispute resolution system is capable of executing a process that sends electronic data to be displayed within a partner system to indicate membership of a particular seller. Moreover, claim 53 as originally filed in the parent application Serial No. 09/504,159, filed February 15, 2000, requires a system, comprising: a network; an electronic marketplace coupled to the network; one or more sellers selling one or more items at the marketplace; one or more buyers consuming one or more items at the marketplace; and a dispute resolution system coupled to the network to resolve a dispute between one or more buyer and seller parties, wherein the dispute resolution system provides a visual indicia to indicate membership in the dispute resolution process. For at least these reasons, a person skilled in the art at the time the application was filed would have recognized that the inventors were in possession of the claim limitation of updating the electronic marketplace based on the data received from the dispute resolution system, as required by claim 61. The Board should reverse the rejection of claims 61 and 62 under 112, first paragraph.

⁴⁵ Para. [0053].

Dependent claim 63

With respect to claim 63, the Examiner appears to assert that she could not support for accessing the dispute resolution system from a website of an electronic marketplace and file disputes *without manually entering the transaction data into the dispute resolution system*. The Board should reverse the rejection of claim 63 under 112, first paragraph for the reasons set forth above with respect to these elements.

Dependent claim 64

With respect to claim 64, the Examiner questioned the claim limitation that the online dispute resolution system receive an electronic query from the marketplace. As explained above, the present application specifically describes a second implementation 150 in which remote software provide within the partner system functionality *to receive and send specific information* to the dispute resolution system 130.⁴⁶ Example functionality described by the application includes informing the dispute resolution system 130 of relevant partner transactions and allowing partner systems “*to query*” the dispute resolution system for data such as the status of a specific marketplace seller 104.⁴⁷ The Board should reverse the rejection of claim 64 under 112, first paragraph for the reasons set forth above with respect to these elements.

Dependent claim 65

With respect to claim 65, the Examiner questioned the claim limitation that the electronic marketplace provide a status to the database of the electronic marketplace. Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to *query* the dispute resolution system data such as the *status of a specific marketplace seller 104*. This makes clear that the inventors contemplated that the software objects executing on a partner system may electronically query (via SQL or other format) online dispute resolution

⁴⁶ Paras. [0045]–[0049].

⁴⁷ Paras. [0045]–[0049].

system 130, receive status of specific marketplace sellers 104 and updating partner databases 164.

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace, as required by claim 65. The Board should reverse the rejection of claim 65 under 112, first paragraph for the reasons set forth above with respect to these elements.

Independent claim 66

With respect to claim 66, the Examiner indicated that she was unable to find support for the requirement of *a software application to automatically communicate transaction data from a database of the electronic marketplace to a database of the dispute resolution system in response to a transaction within the electronic marketplace by a member of the online dispute resolution system.*

As discussed above, FIG. 2B and paragraphs 0046-0047 describe a dispute resolution system 150 in which remote software objects (recited as “a software object” in claim 66) allow a partner system, such as the electronic marketplace, to send specific information to the dispute resolution system to inform the online dispute resolution system of relevant “transactions” within that partner system.⁴⁸ Paragraph 0056 of the present application describes that, after a transaction, a buyer or a seller can dispute a transaction.

Thus, a person skilled in the art at the time the application was filed would have reasonably concluded that the inventor was in possession of the elements required by claim 66. The Board should reverse the rejection of claim 66 under 112, first paragraph for the reasons set forth above with respect to these elements.

⁴⁸ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

Independent claim 67

With respect to claim 67, the Examiner indicated that she was unable to find support for *automatically communicating the transaction data stored to the online dispute resolution system without human intervention in response to initiation of a dispute*. As discussed above, FIG. 2B and paragraphs 0046-0047 describe an embodiment in which dispute resolution system 150 receives specific information from a partner system with respect to relevant “transactions” in that system.⁴⁹

With respect to claim 67, the Examiner indicated that she was unable to find support for utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace. FIG. 10 and paragraph 0085 describe one example of utilizing data describing a transaction in a computer-implemented predictive reasoning process to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”

For at least the reasons set forth above, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention as specified in claims 67. The Board should reverse the rejection under 112, first paragraph.

Independent claim 68

With respect to claim 68, the Examiner indicated that she was unable to find support for *storing transaction data in an electronic marketplace, wherein the transaction data describes transactions within the electronic marketplace*. Paragraph 0039 describes sellers 104 and consumers “consummating transactions” at marketplace 102 with respect to products and/or services in a centralized trading place provided by a web server.⁵⁰ FIG. 2B and paragraph 0047-0048 describe a partner database 164 and describe communication with respect to the database regarding information describing relevant transactions.

⁴⁹ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

⁵⁰ Page 11, ll. 5.

The Examiner also indicated that she was unable to find support for *automatically communicating at least a portion of the transaction data related to the dispute from the electronic marketplace to the online dispute resolution system without manual intervention*. FIG. 2B and paragraphs 0046-0047 describe an embodiment in which dispute resolution system 150 receives specific information from a partner system with respect to relevant “transactions” in that system.⁵¹

The Examiner also indicated that she was unable to find support for *executing a dispute resolution process with the online dispute resolution system that utilizes the transaction data from the electronic marketplace and the case information to assist in resolving the dispute*. FIG. 10 and paragraph 0085 describe one example of utilizing the data in a computer-implemented predictive reasoning process to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”

For at least the reasons set forth above, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention as specified in claims 68. The Board should reverse the rejection under 112, first paragraph.

Independent claim 69

With respect to claim 69 the Examiner indicated that she was unable to find support for executing a dispute resolution process with the online dispute resolution system that receives at least a portion of the transaction data stored from the database of the electronic marketplace without human intervention in response to initiation of the dispute and uses the received portion of the transaction data and the case information from the parties to assist the parties in resolving the dispute.

As set forth above with respect to claims 58 and 73, a person skilled in the art at the time the application was filed would reasonably conclude that the inventor was in possession of the claimed limitation that the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace. Moreover,

⁵¹ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

as also addressed above, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claimed limitation of electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute.

The present application provides numerous examples of dispute resolution system 130 as utilizing data describing the transaction to assist buyers and sellers in resolving the disputes related to those transactions. As one example, FIG. 10 shows “a predictive reasoning process 500” in which the dispute resolution system 130 utilizes data describing a disputed transaction to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”⁵² In this example, the specification makes clear that dispute resolution system 130 uses data describing the transaction to search a historical database to identify previous cases with similar facts. Dispute resolution system 130 then retrieves, summarizes and displays the outcomes of the cases similar to the disputed transaction for all parties and the dispute resolution specialist to assist them in resolving the present dispute.

For at least the reasons set forth above, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention as specified in claims 69. The Board should reverse the rejection under 112, first paragraph.

Independent claim 70

With respect to claim 70, the Examiner indicated that she was unable to find support for the requirement of *an electronic marketplace system that includes a database that stores transaction data that describe transactions*. The Examiner also indicated that she was unable to find support for the requirement of *a software object that automatically communicates the transaction data from the database to the online dispute resolution system when transactions within the electronic marketplace are performed by members of the online dispute resolution system*.

⁵² Para. [0085].

As discussed above, FIG. 2B shows a partner database 164 of a partner system, and paragraph 0047 describes communicating information describing transactions conducted within that partner system. Paragraphs 0046-0047 describe an embodiment in which a remote software object sends specific information from a partner database 164 of a partner system, where the specific information can describe relevant “transactions” in that system.⁵³ Paragraph 0056 of the present application describes that, after a transaction, a buyer or a seller can initiate a dispute. Paragraph 0056 also describes determination of whether the complainant is a member of the online dispute resolution system.

For at least the reasons set forth above, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention as specified in claims 70. The Board should reverse the rejection under 112, first paragraph.

Independent claim 71

With respect to claim 71, the Examiner indicated that she was unable to find support for an electronic marketplace system that includes: a database that stores transaction data that describe transactions for buyers and sellers. As discussed above, paragraph 0039 refers to FIG. 1 and describes marketplace 102 as having a web server that provides an online centralized trading place for buyers 106 and sellers 104. FIG. 2B shows a partner database 164 of a partner system, and paragraph 0047 describes information describing transactions conducted with that partner system.

⁵³ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

The Examiner also indicated that she was unable to find support for *a software object executing within the electronic marketplace system that automatically communicates the transaction data from the database to the online dispute resolution system without human intervention in response to initiation of a dispute*. FIG. 2B and paragraphs 0046-0047 describe remote software objects that send specific information to the dispute resolution system with respect to relevant transactions within a partner system.⁵⁴

The Examiner also indicated that she was unable to find support for *a software object executing within the electronic marketplace system that queries the database of the online dispute resolution system for status for at least one user of the electronic marketplace system*. The present application provides the specific example in which the communication functions of FIG. 2B may be used by a partner system to *query* the online dispute resolution system to determine a specific *status* of a marketplace seller 104.⁵⁵

For at least the reasons set forth above, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention as specified in claims 71. The Board should reverse the rejection under 112, first paragraph.

Independent claim 72

With respect to claim 72, the Examiner indicated that she was unable to find support for *an online dispute resolution system having at least one server that communicates with a database of the electronic marketplace system without human intervention in response to initiation of a dispute*. FIG. 2B shows a dispute resolution system 150 having a database server 160. With respect to FIG. 2B, paragraphs 0048 describe a data manager software object 162 that communicates with databases of partner systems.

Moreover, according to the present application, the systems transparently deals with communication issues including server unavailability and performance when communicating data to the database of online dispute resolution system 130.⁵⁶ These

⁵⁴ See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

⁵⁵ See 0047 stating that “[e]xample functionality includes ... allowing partners to query the dispute resolution system data such as the *status* of a specific marketplace seller 104 (emphasis added).

⁵⁶ Para. [0047].

sections make clear that the software objects *transparently* communicate the partner data from the partner system to the online dispute resolution system 130. Thus, although the specification does not include the exact words of “communicat[ing] transaction data to the online dispute resolution system electronically without manually entering the transaction data into the dispute resolution system,” it is clear that the present inventors contemplated and described certain embodiments of transparent electronic transfer of transactions from the database 164 of the marketplace 102 to the database 160 of the online dispute resolution system. If indeed manual reentry of transactions were required by online dispute resolution system, contrary to the second embodiment 150 of the present application, then partner database 164 would not be accessed and server 156 would not “receive data” from the database informing the online dispute resolution system 130 of “partner transactions,” as expressly described by the present application.

For at least the reasons set forth above, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention as specified in claims 72. The Board should reverse the rejection under 112, first paragraph.

The Second and Third Grounds of Rejection

The second ground of rejection to be reviewed on appeal is the rejection of claims 49-61 and 64-72 under 35 U.S.C. 102(e) as being anticipated by Collins et al. (U.S. Publication No. 2002/0007362). The third ground of rejection to be reviewed on appeal is the rejection of claims 62 and 63 under 35 U.S.C. § 103(a) as being unpatentable over Collins. Appellant argues claims 49-61 and 64-72 as a group, and directs the Board to claim 73.

The issue for review by the Board is that the Examiner improperly relied on the Collins reference as prior art. For purposes of this appeal, as discussed below, the second and third grounds of rejection are rendered moot if the Board reverses the rejection of Appellant’s claims under 35 U.S.C. 112, first paragraph.

The present application is a continuation of and claims priority to Serial No. 09/504,159, filed February 15, 2000. Collins was filed April 28, 2000, which is nearly two months after Appellant’s priority date of February 15, 2000, but claims priority to

three U.S. provisional applications filed prior to the priority date of the present application.

In the previous responses, Appellant pointed out that subject matter of Collins relied upon by the Examiner is unsupported by the Collins provisionals and, therefore, does not qualify as prior art under 102(e). MPEP 2136.03 states that the 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application if the provisional application(s) properly supports the subject matter relied upon to make the rejection is in compliance with 35 U.S.C. 112, first paragraph.

The Collins provisionals describe only a stand-alone complaint-handling system in which all parties directly access the Collin's complaint handling system and manually enter all data describing a situation.⁵⁷ The Collin's provisionals provide no teaching or suggestion of a system in which any form of data is automatically communicated to an online marketplace system from a marketplace, let alone to inform an online dispute resolution system of transactions within the marketplace.

The features relied upon by the Examiner, namely FIG. 1B and the related description in paragraph [0045], are not taught or even remotely suggested by any of the Collins provisionals that predates Appellant's filing data. In particular, Appellant can find no teaching or mention within the priority documents that would provide a basis for satisfying the requirements of 112, first paragraph, either expressly, implicitly or inherently. Consequently, in accordance with MPEP 2136.03, with respect to the subject matter shown and described with respect to FIG. 1B of the Collins reference does not receive the benefit of the filing dates of the provisionals. This disclosure formed the primary basis for the Examiner's rejection, and thus the rejection of claims 49–61 and 64–72 must be withdrawn.

⁵⁷ Collins at [0037]-[0038] (stating that Party A "initiates a negotiation session by connecting with the central server 120 [of the complaint handling system] and providing data to the central server 120 concerning the nature of the situation and the identity of party B." Party B then responds by providing his or her position data to the same system. With respect to the embodiment of Figure 1A, Collins describes Parties A and Parties B interacting with the central server 120 by interacting with HTML "templates."

On this point, the Examiner's only rebuttal was to rely on the 112, first paragraph, rejection of Appellant's claims discussed above. Specifically, the Examiner's asserted that Appellant's pending claims fail to comply with the written description requirement and, therefore, fail to receive the benefit of the priority date of the Appellant's parent application.⁵⁸ Based on this reasoning, the Examiner concluded that reliance on Collins is proper.

The Examiner has made *no attempt* to demonstrate that the subject matter of Collins relied upon by the Examiner *is* supported by the earlier filed Collins provisional documents. The Examiner has not made *any* argument that the Collins priority documents satisfy the requirements of 112, first paragraph, either expressly, implicitly or inherently, with respect to the disclosure relied upon in forming the rejections under 35 U.S.C. §§ 102, 103. The Examiner has made no reference whatsoever to the Collins' provisional documents. The Examiner has, in effect, conceded that the portions of Collins relied upon by the Examiner in rejecting the claims under 35 U.S.C. §§ 102, 103 do not constitute prior art with respect to Appellant's priority date, and instead has relied exclusively on the rejection of Appellant's claims under 35 U.S.C. 112, first paragraph. Consequently, the rejections under 35 U.S.C. 102, 103 are rendered moot in the event the Board reverses the rejection of Appellant's claims under 35 U.S.C. 112.

⁵⁸ Final Office Action, pg. 40.

Conclusion of Arguments

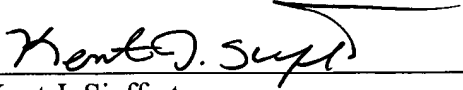
Appellant claims 49-73 comply with the written description requirement. The Examiner's rejection under 35 USC 112, first paragraph, is improper and should be reversed. As this is the Examiner's sole basis for the rejection under 35 USC 102 and 103, these rejections are also improper and the claims should be allowed.

Respectfully submitted,

Date: September 11, 2006

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APPENDIX: CLAIMS ON APPEAL

Claims 1-48 (Canceled).

Claim 49 (Previously Presented): A system comprising:

an online dispute resolution system electronically coupled to an electronic marketplace, wherein the electronic marketplace stores transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services,

wherein, in response to initiation of a dispute, the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data, and

wherein the dispute resolution system utilizes the received portion of the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions.

Claim 50 (Previously Presented): The system of claim 49, wherein the online dispute resolution system electronically receives communications from the buyers and sellers of the electronic marketplace to initiate filing of disputes with the online dispute resolution systems for transactions within the electronic marketplace.

Claim 51 (Previously Presented): The system of claim 49, wherein the online dispute resolution system electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system.

Claim 52 (Previously Presented): The system of claim 49,
wherein the online dispute resolution system comprises a membership profile database that maintains status information for the sellers and buyers of the marketplace that are members of the online dispute resolution system, and
wherein the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace.

Claim 53 (Previously Presented): The system of claim 49, wherein the online dispute resolution system further comprises a server to service electronic requests issued by a server within the electronic marketplace and to exchange data between the online dispute resolution system and the electronic marketplace.

Claim 54 (Previously Presented): The system of claim 49, wherein the online dispute resolution system comprises a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace.

Claim 55 (Previously Presented): The system of claim 49,
wherein the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a database of the electronic marketplace,
wherein the rating data relates to participation of the buyers and sellers of the marketplace within the online dispute resolution process.

Claim 56 (Previously Presented): The system of claim 55, wherein the online dispute resolution system maintains the rating data based on compliance of the buyers and sellers to final decisions made in the resolution of the disputes.

Claim 57 (Previously Presented): The system of claim 49, wherein the electronic marketplace presents a web-based interface having embedded uniform resource locators that are associated with the dispute resolution system that enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace and automatically initiate the filing of disputes relating to the transactions.

Claim 58 (Previously Presented): A method comprising:
providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace;
electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute; and
utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

Claim 59 (Previously Presented): The method of claim 58, further comprising:
electronically receiving with the online dispute resolution system communications from the users of the electronic marketplace to initiate filing of disputes; and
initiating the online dispute resolution process in response to the communications.

Claim 60 (Previously Presented): The method of claim 58, further comprising:
electronically receiving with the online dispute resolution system enrollment requests from the sellers of the marketplace; and
automatically initiating enrollment of the sellers within the dispute resolution system in response to the requests.

Claim 61 (Previously Presented): The method of claim 58, further comprising:
electronically communicating data that relates to the online dispute resolution process to the database of the electronic marketplace, and
updating the electronic marketplace based on the data received from the dispute resolution system.

Claim 62 (Previously Presented): The method of claim 61, wherein updating the electronic marketplace comprises:
displaying in the electronic marketplace visual indicia associated with users of the electronic marketplace that participate in the dispute resolution system; and
controlling the appearance of the visual indicia as a function of data received from the dispute resolution system for the users in response to resolution of the disputes.

Claim 63 (Previously Presented): The method of claim 58, further comprising embedding uniform resource locators associated with the dispute resolution system within a hypertext markup language application for the website of the electronic marketplace to enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace and file disputes without manually entering the transaction data into the dispute resolution system.

Claim 64 (Previously Presented): The system of claim 49, wherein the online dispute resolution system receives an electronic query from the marketplace and provides a status of a marketplace member of the marketplace in response to the query.

Claim 65 (Previously Presented): The method of claim 58, further comprising:
receiving with the online dispute resolution system an electronic query from the electronic marketplace; and
electronically providing a status associated with one of the users from a database of the online dispute resolution system to the database of the electronic marketplace in response to the query.

Claim 66 (Previously Presented): A system comprising:
a dispute resolution system electronically coupled to an electronic marketplace for buyers and sellers of goods and services; and
a software application to automatically communicate transaction data from a database of the electronic marketplace to a database of the dispute resolution system in response to a transaction within the electronic marketplace by a member of the online dispute resolution system,
wherein the transaction data is associated with one or more transactions within the electronic marketplace, and
wherein the dispute resolution system utilizes the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions.

Claim 67 (Previously Presented): A method comprising:
providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace stores transaction data that describes transactions within the marketplace;
automatically communicating the transaction data stored to the online dispute resolution system without human intervention in response to initiation of a dispute; and
utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

Claim 68 (Previously Presented): A method comprising:

storing transaction data in an electronic marketplace, wherein the transaction data describes transactions within the electronic marketplace;

receiving case information with an online dispute resolution system, wherein the case information describes a dispute related to one of the transactions of the electronic marketplace;

automatically communicating at least a portion of the transaction data related to the dispute from the electronic marketplace to the online dispute resolution system without manual intervention; and

executing a dispute resolution process with the online dispute resolution system that utilizes the transaction data from the electronic marketplace and the case information to assist in resolving the dispute.

Claim 69 (Previously Presented): A method comprising:

storing transaction data in a database of a electronic marketplace, wherein the transaction data describe transactions within the electronic marketplace;

receiving case information with an online dispute resolution system from one or more parties, wherein the case information describes a dispute related to one of the transactions of the electronic marketplace; and

executing a dispute resolution process with the online dispute resolution system that receives at least a portion of the transaction data stored from the database of the electronic marketplace without human intervention in response to initiation of the dispute and uses the received portion of the transaction data and the case information from the parties to assist the parties in resolving the dispute.

Claim 70 (Previously Presented): A system comprising:

- an online dispute resolution system that presents an interface for receiving case information from one or more parties; and
- an electronic marketplace system that includes:
 - a database that stores transaction data that describe transactions, and
 - a software object that automatically communicates the transaction data from the database to the online dispute resolution system when transactions within the electronic marketplace are performed by members of the online dispute resolution system,

wherein the online dispute resolution system executes a dispute resolution process that utilizes the transaction data and the dispute information to assist the parties in resolving the dispute.

Claim 71 (Previously Presented): A system comprising:

- an online dispute resolution system having a database of case information for a dispute; and
- an electronic marketplace system that includes:
 - a database that stores transaction data that describe transactions for buyers and sellers,
 - a software object executing within the electronic marketplace system that automatically communicates the transaction data from the database to the online dispute resolution system without human intervention in response to initiation of a dispute, and
 - a software object executing within the electronic marketplace system that queries the database of the online dispute resolution system for status for at least one user of the electronic marketplace system.

Claim 72 (Previously Presented): A system comprising:
a server that provides an electronic marketplace system;
a plurality of client computers by which buyers and sellers interact with the electronic marketplace system; and
an online dispute resolution system having at least one server that communicates with a database of the electronic marketplace system without human intervention in response to initiation of a dispute.

Claim 73 (Previously Presented): A system comprising:
an online dispute resolution system that executes a dispute resolution process; and
an electronic marketplace system that includes:
(i) a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers,
(ii) a database that stores data, and
(iii) a software object that communicates the data from the database to the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system.

APPENDIX: EVIDENCE

None

APPENDIX: RELATED PROCEEDINGS

None